

REMARKS

Reconsideration of the pending application is respectfully requested in view of the foregoing amendments and the following remarks.

Status of the Application

Claims 1-10 are currently pending, with claim 1 being amended. As the amendment to claim 1 is fully supported by the application as filed, *e.g.*, page 4 of the application, no new matter has been introduced into the application by way of these amendments.

Summary of the Office Action

The Office Action opens by rejecting claims 1-10 under 35 U.S.C. § 112, second paragraph, as allegedly failing to provide sufficient antecedent basis for “the solubilizing groups G¹ and G² are anionic.”

Claims 1-10 are also rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,893,797 (Munnelly et al.).

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 6,864,040 (Muller et al.).

Discussion

Turning initially to the Section 112 rejection, Applicants have amended claim 1. As there is proper antecedent basis for G¹ and G² in the claim, withdrawal of the rejection is respectfully requested.

Turning to the substantive rejections, Applicants respectfully submit that claims 1-10 are not anticipated by Munnelly et al.

Munnelly discloses at column 6, line 50, cyanine dyes having the structure of formula A. The different substituting groups are defined therein, but there is no disclosure that the infrared light absorbing compound comprises *inter alia* “three, four or five of the solubilizing groups G¹ or G²” as required by the pending claims. On the contrary column 7, lines 18-23 of Munnelly et al. disclose substituent groups, but fails to disclose an infrared light absorbing compound comprising solubilizing groups as described in the claimed invention, the latter including *inter alia* “G¹ and G² are solubilizing groups and are anionic or become anionic in

an aqueous alkaline solution having a pH of at least 9.” Indeed, Munnelly et al. fails to disclose the use of “three, four or five of the solubilizing groups G¹ or G²” as required by the pending claims.

For at least the foregoing reasons, Applicants respectfully request withdrawal of the anticipation rejection of claims 1-10 based on Munnelly et al.

Turing to the obviousness rejection of claims 1-10 over Muller, Applicants respectfully submit that Muller et al. fails to teach or suggest the invention as claimed.

Muller et al. discloses at column 4, line 20, cyanine dyes having the structure of formula A. Various substituent groups are identified, and defined at column 4, lines 30-43 for R¹, R² and R³ and also for the counter anion A⁻. Muller et al., however, fails to teach that for the groups R¹, R² and R³, there must be 3, 4 or 5 solubilizing anionic groups, *i.e.*, the infrared light absorbing compound comprises *inter alia* “three, four or five of the solubilizing groups G¹ or G², wherein “G¹ and G² are solubilizing groups and are anionic or become anionic in an aqueous alkaline solution having a pH of at least 9,” as required by the pending claims. On the contrary, Muller et al. fail to teach the use of anionic solubilizing groups as its substituent groups. *See, e.g., Muller et al., col. 4, lines 52-57.*

The mention of the group at column 4, lines 65-67, in the Office Action is not relevant, as this relates to the description of the counter anion A⁻. This, of course, has nothing to do with teaching the claimed invention which provides an infrared light absorbing compound comprising *inter alia* “three, four or five of the solubilizing groups G¹ or G²,” and wherein “G¹ and G² are solubilizing groups and are anionic or become anionic in an aqueous alkaline solution having a pH of at least 9.” This same argument is applicable to the dyes mentioned in the Office Action at column 5, lines 1-8, and column 6, lines 1-8, wherein only the counter anion A⁻ is discussed in those two passages.

For at least the foregoing reasons, Applicants respectfully request withdrawal of the obviousness rejection of claims 1-10 based on Muller et al.

Conclusion

As Applicants believe the application is in proper condition for allowance, the examiner is respectfully requested to pass the application to issue. If, in the opinion of the

Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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